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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/784,949	02/25/2004	Xavier Blin	05725.1262-00	8436
22852	7590	02/03/2010	EXAMINER	
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			CHANNAVAJALA, LAKSHMI SARADA	
			ART UNIT	PAPER NUMBER
			1611	
			MAIL DATE	DELIVERY MODE
			02/03/2010	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

<b>Application No.</b> 10/784,949	<b>Applicant(s)</b> BLIN ET AL.	
<b>Examiner</b> Lakshmi S. Channavajjala	<b>Art Unit</b> 1611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1)  Responsive to communication(s) filed on 12 November 2009.
- 2a)  This action is **FINAL**.                      2b)  This action is non-final.
- 3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4)  Claim(s) 1,3-5,8-19 and 21-64 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5)  Claim(s) \_\_\_\_\_ is/are allowed.
- 6)  Claim(s) 1,3-5,8-19 and 21-64 is/are rejected.
- 7)  Claim(s) \_\_\_\_\_ is/are objected to.
- 8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9)  The specification is objected to by the Examiner.
- 10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All    b)  Some \*    c)  None of:
- Certified copies of the priority documents have been received.
  - Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

Receipt of amendment and response dated 11-12-09 is acknowledged.

Claims 2, 6, 7, and 20 have been cancelled. Claims 1, 3-5, 8-19, and 21-64 are pending in the instant application.

#### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11-12-09 has been entered.

In light of the amendment to claims 1 and 60 to limit the claims to polysiloxane of structural formula IV, the rejection of record (dated 7-1-09) has been withdrawn.

However, the following new rejection has been applied:

#### ***Claim Rejections - 35 USC § 112***

2. Claim 23 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 23 recites that the polymer particles of the first composition may be silicone polymers. Instant claim 1 recites a first and a second composition where the first composition comprises a liquid fatty phase with polymer particles dispersed therein. It is unclear that if the two phases comprise a polysiloxane,

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according to claim 23, how does the cosmetic product remain as two compositions- a first and a second. A clarification is requested.

***Double Patenting***

3. Claims 1, 3-5, 8-19, and 21-64 are- rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over 1-130 of U.S. Patent No. 6,811,770 in view of US 6,180,123.

4. Claims 1-64 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-130 of U.S. Patent No. 6,811,770.

Although the conflicting claims are not identical, they are not patentably distinct from each other. Instant claims recite a two-composition product comprising a first composition with a liquid fatty phase with polymer particles dispersed in there and a second composition comprising a silicone polymer of high molecular weight of structural formula IV. Instant claims also recite a method of applying the composition to the skin and a kit.

5. The patented claims ('770) recite a process of applying a cosmetic composition to the skin or lips comprising a first coat made of a dispersed polymer in a liquid fatty phase and a surface stabilizer, and a second composition comprising silicon or fluoro based liquid phase. The polymers dispersed in first phase, their amounts, the surface stabilizer, other excipients such as wax, gelling agents, the particle size of dispersed polymers and the compounds of the second composition described in the patented claims are also described in the instant claims. The patented claims differ from the instant claims in the silicone polymer of the second composition. While claim 1 of the

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patent generally states silicone polymers, there is no structural formula or description of the same and further the dependent claims recite phenyl silicones that are different from the instant claimed silicones.

6. US 6180123 (US 123) describes a supple, flexible and a non-sticky makeup composition comprising a polymer which is dispersible or soluble in a liquid fatty phase (col. 2, summary of the invention; col. 5, L 42-50). US 123 teaches the compositions for the same applications as that claimed in the instant application i.e., as a makeup and non-transferring properties. US 123 further teaches inclusion of thickening agents in the composition and suggests high molecular silicone polymers such as polydimethylsiloxane-methylvinylsiloxane or polydimethylsiloxane-phenylmethylsiloxane or polydimethylsiloxane-diphenylsiloxane (col. 12, l 12-38). Thus, US 123 teaches equivalence of silicone polymers and phenylsilicone polymers (recited the patented claims of US '770. Both the patents are directed to the same type of cosmetic compositions and for the same purpose and therefore a skilled artisan would have recognized that high molecular weight silicone polymers generally afford thickening effect to the composition. Therefore, it would have been obvious for a skilled artisan at the time of the instant invention was made to employ a suitable silicone polymer of high molecular weight such as those taught by US 123 in the composition of the patented claims of '770 and still expect a desired thickening effect . In this regard instant comprising language allows for the presence of phenyl or fluorosilicone polymers of the '770 patented claims in addition to the silicone polymers of instant second composition.

***Claim Rejections - 35 USC § 103***

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

8. Claims 1, 3-5, 8-19, and 21-64 rejected under 35 U.S.C. 103(a) as being unpatentable over US PGPUB 2003/0039621 to Arnaud et al OR over US 6811770 each in view of US 6,180,123.

1. Arnaud discloses a cosmetic make-up product containing a first and a second composition, the first composition comprising, in a physiologically acceptable medium, dispersed polymer particles surface-stabilized with a stabilizer in a liquid organic phase and a coloring agent, and the second composition comprising a second physiologically acceptable medium (abstract). The compositions may be packaged together or separately (0026). The composition is applied as a base coat and then as a top coat to the composition (0029). The composition is suitable for application as a makeup for face, lips, eyeliners, hair care etc. (page 2). For the polymer dispersion, Arnaud teaches polymer nanoparticles of 5 nm to 800 nm (0049) and a molecular weight of 2000 to 10,000,000 (0051). The first composition of Arnaud comprises polymer particles in dispersion, which is soluble in the liquid organic phase or fatty phase (paragraph 0044). Film-forming polymers may be used (paragraph 0054). The amount of polymer may be greater than 2% by weight (paragraph 0045). Examples of film forming polymers include polyurethanes, polyurethane-acrylics, polyureas, polyurea-polyurethanes, polyester-polyurethanes, polyether-polyurethanes, polyesters, polyester amides, alkyd fatty-chain polyesters; acrylic and/or vinyl polymers or copolymers; acrylic-silicone copolymers;

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polyacrylamides; silicone polymers, for instance silicone acrylics or polyurethanes, fluoro polymers, and mixtures thereof (paragraph 0072). For the stabilizer, Arnaud teaches random block or graft polymers (0075-0089). The compositions may be in anhydrous form (paragraph 0225), or each composition may have the appearance of a lotion, cream, ointment, soft paste, salve, a cast or molded solid, or a more or less rigid stick (paragraphs 0226-0227). For the liquid fatty phase, Arnaud describes several oils both volatile and non-volatile (0103- 0105) and in an amount of 20-90%. For the thickeners, Arnaud teaches gelling agents (0115). Arnaud further teaches adding wax, fillers, coloring agents etc (0116-0139). For the second composition, Arnaud teaches liquid phase (0151-0156, 0168), in particular, the fluorosilicone compound of formula I (0169), which reads on the instant polymer of second composition and other silicone compounds (170+). Further, the examples show the two compositions described by Arnaud.

2. The teachings of US '770 are described in the previous paragraphs. The composition of US '770 also employs the instant claimed first and second compositions, with the same polymer particles in the first phase and the silicone polymers that make up the second phase.

3. Both Arnaud and US '770 generally states silicone polymers, there is no structural formula or description of the same and further the dependent claims recite phenyl silicones that are different from the instant claimed silicones.

4. US 6180123 (US 123) describes a supple, flexible and a non-sticky makeup composition comprising a polymer which is dispersible or soluble in a liquid fatty phase

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(col. 2, summary of the invention; col. 5, L 42-50). US 123 teaches the compositions for the same applications as that claimed in the instant application i.e., as a makeup and non-transferring properties. US 123 further teach inclusion of thickening agents in the composition and suggest high molecular silicone polymers such as polydimethylsiloxane-methylvinylsiloxane or polydimethylsiloxane-phenylmethylsiloxane or polydimethylsiloxane-diphenylsiloxane (col. 12, l 12-38). Thus, US 123 teach equivalence of silicone polymers and phenylsilicone polymers (recited the patented claims of US '770. Both the patents are directed to the same type of cosmetic compositions and for the same purpose and therefore a skilled artisan would have recognized that high molecular weight silicone polymers generally afford thickening effect to the composition. Therefore, it would have been obvious for a skilled artisan at the time of the instant invention was made to employ a suitable silicone polymer of high molecular weight such as those taught by US 123 in the compositions Arnaud or US '770 and still expect a desired thickening effect because US '770 suggests high molecular weight silicone polymers with or without phenyl group to be effective in providing thickening effect. With respect to the hydroxy substituted silicones, a skilled artisan would understand from the teachings of '123 that any high molecular weight silicone gum irrespective of the substitution (vinyl, phenyl, alkyl) would provide thickening effect and in the absence of any unexpected advantage a skilled artisan would have employed any silicone polymer of high molecular weight so long as the composition provides thickening effect.



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***Response to Arguments***

5. Applicant's arguments, that Arnaud and "770 patent fails to teach instant silicone polymer of formula IV, filed 11-12-09, have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made as above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lakshmi S. Channavajjala whose telephone number is 571-272-0591. The examiner can normally be reached on 9.00 AM -5.30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sharmila G. Landau can be reached on 571-272-0614. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Lakshmi S Channavajjala/  
Primary Examiner, Art Unit 1611  
February 1, 2010